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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 88

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JOSEPH MORT and MARY A. MACHONKIN
Junior Party[1]

v.

RONALD F. ZIOLO
Junior Party[2]

v.

DONALD R. HUFFMAN and WOLFGANG KRATSCHMER
Senior Party[3]

Interference No. 103,281

DECISION ON RECONSIDERATION

Before METZ, SCHAFER and LEE, Administrative Patent Judges.

METZ, Administrative Patent Judge.

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[1] Patent Number 5,114,477, granted May 19, 1992, based on Application 07/754,084, filed September 3, 1991. Assignor to Xerox Corporation, Stamford, Connecticut.

[2] Patent Number 5,188,918, granted February 23, 1993, based on Application 07/709,734, filed June 3, 1991. Assignor to Xerox Corporation, Stamford, Connecticut. (Ziolo II).

[3] Application 07/580,246, filed September 10, 1990. No Assignee of record.

On October 14, 1999, Ziolo, the juniormost party, and Mort et al., the junior party (hereinafter "the junior parties"), filed a request pursuant to 37 C.F.R. § 1.658(b) for reconsideration (Paper Number 86) from our final decision mailed on September 23, 1999 (Paper Number 84). Huffman et al., the senior party, filed an opposition to the request for reconsideration on October 26, 1999 (Paper Number 87). The time for filing a request for reconsideration expired on October 23, 1999.

Requests for reconsideration must set forth with particularity the points believed to have been misapprehended or overlooked by us in rendering our decision. 37 C.F.R. § 1.658(b), second sentence. Mere disagreement with our decision on the merits is not a proper basis for requesting reconsideration.

We have carefully considered the junior parties' request in its entirety but find that the request lacks both specific references to what we are alleged to have "overlooked or misapprehended" in rendering our decision and the request lacks particular citations to where in their brief they allegedly made the arguments which are the foundation of their request. The request is a combination of (1) re-argument of points already raised by the junior parties and decided in our decision and (2) new points of argument made with the benefit of our decision. Suffice it to say that the request does not set forth "with

particularity the points believed to have been misapprehended or overlooked in rendering the decision."

In the request, the junior parties assert that our decision ignores the jurisdictional issues raised by both parties in their briefs. The junior parties are, simply, wrong. At pages 8 and 9 of our decision, under the heading "**JURISDICTION**", we found:

> the parties do not dispute that when properly declared the Board has jurisdiction to conduct an interference proceeding, and the issue of whether the interference was properly declared was submitted to the Commissioner via petition and the Commissioner has ruled that this interference was properly declared.
>
> We do not sit to review the Commissioner's decision on petition. The parties' recourse would have lied in a civil action for a *writ of mandamus*.

The statute is also plain on this issue. 35 U.S.C. § 135 (a), first sentence, commits to the Commissioner both the discretionary authority to declare an interference and, when an interference is determined to exist, the authority to give notice to the parties of such declaration. Stripped of all its sophistry, the junior parties' argument concerning jurisdiction is merely a continuation of their argument that there is no interference-in-fact between the parties. Suffice it to say that we have exhaustively addressed this issue in our decision at pages 10 through 18 thereof.

The junior parties also argue that our decision was "incomplete (and dangerously misleading) from another respect." (see page 6 of the request). Specifically, the junior parties suggest that we held that the duty of disclosure does not apply to parties involved in an interference. Once again, the junior parties are, simply, wrong. The junior parties asked us to impose sanctions against senior party. "See the junior parties' main brief at page 18 and the junior parties' reply brief at page 3." We specifically held at page 55 of our decision that:

> we are only authorized to issue sanctions for failure by a party to comply with the rules or any order issued by us. See 37 C.F.R. 1.616(a). We never ordered the senior party to inform us of the existence of any pending application directed to the process of making fullerenes in macroscopic amounts. Since we never ordered Huffman et al. to notify us of the existence of such applications, they cannot have violated an order we never issued. Even assuming, *arguendo*, such applications exist, the mere existence of such applications does not establish the materiality of such applications to <u>this</u> proceeding. We also observe that 37 C.F.R. § 1.656(b)(2) does <u>not</u> require a party to identify related applications but only "any related appeal or interference which is pending before, or which has been decided by the Board" as "related" is defined in the last sentence of rule.
>
> Finally, in their brief, Huffman et al. <u>have</u> included a statement of other related appeals and interferences.

> Therein Huffman et al. state unequivocally that they know of no appeals or interferences related to this proceeding (see page 1 of their brief). The rule requires no more and we have no reason to doubt Huffman et al.s' representation.

The junior parties also urge that our decision was incomplete in our treatment of the junior parties' request to strike Huffman et al.'s Exhibit 3 (the videotape) as alleged hearsay evidence (page 6 of the request). Again, the junior parties are, simply, wrong. In our decision we specifically held at page 56 that:

> beyond their characterization of the tape as hearsay, the junior parties have not explained the basis for their hearsay objection to the tape. More significantly, the junior parties' briefs are replete with references to and reliance on the videotape for a variety of purposes beyond those portions of the tape which the junior parties have characterized as "admissions against interest". Even more significantly, the junior parties did not file a proper motion to suppress the tape under 37 C.F.R. § 1.656(h). We have considered the videotape to the extent indicated in this opinion and shall not suppress same as hearsay.

37 C.F.R. § 1.656(h) requires a motion to suppress be filed with their brief if a party wants the Board to rule on the admissibility of any evidence. The junior parties filed no motion to suppress with their brief.

Finally, the junior parties urge that there was inadequate evidence presented in the record by Huffman et al. to "overcome the presumption of correctness of the three Judge preliminary decision in this interference rejecting other Sr. party claims" (page 7 of the request). Apparently, this is a reference to 37 C.F.R. § 1.655(a), third sentence, **before** it was amended, effective March 16, 1999, by publication of the interim final rule. See 64 F.R. 12900. At the time we rendered our opinion, there was no longer a presumption of the correctness of any interlocutory decision based on any substantive issue. Rather, review of the issues raised below on the merits now constitute a *de novo* review of those issues.

Accordingly, the request is granted to the extent we have reconsidered our decision but is **DENIED** because we decline to modify our decision in any respect.

RECONSIDERATION DENIED

ANDREW H. METZ)
Administrative Patent Judge)
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RICHARD E. SCHAFER)BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
)INTERFERENCES
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)
JAMESON LEE)
Administrative Patent Judge)

AHM/gjh

Interference No. 103,281

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